The Relation of "Novelty" and "Invention" to the Citation of Art

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The Relation of "Novelty" and "Invention" to the Citation of Art

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This paper will endeavor to discuss briefly the relation of "invention" and "novelty" to the citation of art. That is, to consider how far it is advisable, or perhaps even legally proper, to refuse to cite art against a claim when the question is only one of "novelty" or "invention."

The question is not concerned with division, multiplicity of claims, incomplete combination, inoperativeness, lack of utility, lack of disclosure, new matter, abandonment of the invention, vital indefiniteness of the claim, or failure to define an invention in one of the statutory classes. It will be assumed that none of these causes of rejection exists.

It has always been the practice in Division 39 to assume that when a useful, operative, complete thing has been devised, some problem has been solved; as Robinson reiterates, something has been devised to satisfy a want believed by the deviser to exist.

Further, that there exists among those fully skilled in the art concerned what may be called a certain "sum of information" as to properties and capabilities in the things related to the art; information derived from study of these things in their separate and collective activity.

The "sum of information" possessed by the deviser may be very much smaller than that possessed by those fully versed in the art, so that he may in all honesty become an applicant for a patent when he is not entitled to it, even though he may have performed an act of in-

vention considered with reference to his own "sum of knowledge."

In investigating the question of patentability of such a presented thing, the things known to those fully skilled in the art, whether they are elements or single steps or subcombinations, are considered, not as the bare things themselves, but as those things with their known capabilities and properties. And just as a chemical element or subcombination may be represented, not by its symbol or symbols alone, but in addition by the conventional radiating lines to indicate known properties and capabilities of the elements, etc., so a mechanical element or subcombination is conceived of as bearing such lines.

If now, for example, one known mechanical element is combined with another in an operative device, one or more of these lines become bonds, and define the cooperation between the elements. The properties and capabilities represented by the inactive lines, that is, those which do not become bonds, are not concerned with the combination, as such, however valuable such inactive properties may be when the element is used in other combinations wherein they become bonds. In the well-known McNeil case, 100 O. G., pages 1976 and 2178, there were recited or implied certain features of a new stitcher which did enter into the combination with a trimmer, and certain other features of the stitcher which did not in fact enter into the combination. The art showed a combined stitcher and trimmer with equivalent bonds though not with lines equivalent to those recited, but which did not affect the combination. These latter lines were properly ignored, and S-T was decided to be the equivalent of S′-T, the hyphen representing the bonds.

As is clearly set forth by Robinson in his long discussion of novelty, a claimed thing may have its equivalent in a single known thing, or in that thing modified within the art, or in a thing made up of elements or subcombinations existing in the known art and chosen and cooperatively arranged within mechanical skill.

The "sum of knowledge" belonging to those skilled in an art and the manipulation of its material within mechanical skill are the property of the public, or of some patentee, and to pass eventually to the public; and a pro-

duced thing which rises within the territory of that perpetual monopoly can not create a new monopoly.

Thus, let us assume in a valve application a combination claim to a specific form of reciprocating valve stem, and a specific form of indicator to represent the immediate height of the stem. Graphically this could be represented by S′-I′. Such a combination might be unpatentable in view of the simple combination S-I alone, or that simple combination modified by substituting for one or both of the simple elements in that basic patent, corresponding elements with equivalent primes and old in the art, or even by a joining for the first time of these prime elements or their equivalents, such union being within the art. That is, in the last condition, it may even be proper to choose as the basic patent one showing less than the number of elements, and add to that element or elements to produce the greater number. Ex parte Perkins, 88 O. G., page 548. Thus, if no vertically moving valve-stem had ever been combined with a height indicator, a claim to the combination might properly be rejected on reciprocating valve stem alone since it would involve no invention to add an indicator in view of, for example, a float carrying a reciprocating stem, the latter provided with a height indicator. That is, it is sometimes proper, and a clearer action, to cite as the basic reference a thing which has the defect which the applicant has cured, and show that no inventive act has been performed in the cure because an equivalent defect has been cured in an equivalent way, in a thing so nearly like that in the application that the transfer of the cure does not involve invention. Such an action sometimes results in a clearer issue than, for example, the citation as a basic reference of the combined float and indicator, and the substitution of a valve-stem for the float. This collecting is sometimes called by applicants, "building," and its propriety should be clear, because the burden of showing lack of invention is heavier. All such actions are only applications of the doctrine of equivalents, and may be extended to elements or to combinations of any number of elements. And nearly all inventions may be classed as combinations in a way, since nearly all product claims recite a combination of features.

Of what wide range is this doctrine of equivalence may be seen by the following quotation from Robinson's great work.*

The quotation as to equivalents is in Vol. I, on page 339:

> "Similarity in individual character does not create, nor does diversity in individual character destroy equivalence between such acts and substances as are thus capable of substitution for each other. However unlike in name, shape, size, capacity, proportions, arrangement or material they may appear to be, when studied only in connection with each other, if when brought into their position in the art or instrument their interchangeability is manifest, those individual variations become of no importance. Equivalence resides in use, not in intrinsic attributes; and similarity of use alone is necessary to make one act or substance the equivalent of another."

This sweeping statement of Robinson finds, I think, an analogy in language. Words may develop in particular combinations properties quite unexpected. An automobilist passed a sign, "slow down," and shortly after a sign, "slow up." In these two simple combinations the words "up" and "down" are equivalents, though of diametrically opposite meaning when standing alone.

This doctrine of equivalents is so comprehensive and so complete that it has satisfied all requirements in Division 39 as to questions of novelty and legal invention, and has made unnecessary the use, as a substitute for cited art or as a supplement to it, of any indefinite word or expression.

Thus, for example, the word "aggregation" is never

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*I may say that practically all the quotations are from that work. There are many valuable hand books of patent law, but Mr. Robinson has so profoundly analyzed and applied the principles of the law, studying it at the fountain head, that his book seems of a different kind. The other works, in spite of their value as reference books, have, naturally, in view of their object, the peculiarity that Robinson notes as to a line of court decisions; law is studied in the light of cases, rather than cases in the light of the law. I believe if Mr. Robinson had written his work earlier, and had in consequence, been appointed and served for some years as a federal judge, he would have made a scientifically accurate use of the principles he disclosed, using them as one uses tools; and his explanations of such use would have so elucidated patent practice that it would have become uniform and accurate both in the courts and in the office.

used, and is intentionally avoided because of its loose meaning.

I would like to state briefly why the word "aggregation" seems to me an unfortunate one in patent practice.

It seems to have begun its career innocently enough in the well-known case of Hailes *vs.* Van Wormer, 20 Wallace, page 353, the construction involved being a stove combining a magazine feed with a down draft. Magazine stoves with up-drafts had the defect that the heat of the products of combustion rising contiguous to the magazine heated the latter enough to release gas from the fuel in the magazine, causing puffs of gas into the room. The down-draft stove had been fed by hand. The court held that the union of the magazine and down-draft was selection within the art, and discussed and applied the art very fully. (It is doubtful whether the down-draft, by developing its new capacity of drawing the products away from the magazine, did not make the combination patentable.)

In addition to such complete application of the art the court said:

> "But the results must be a product of the combination and not a mere aggregate of several results, each the complete product of one of the combined elements."

In the very next case of real importance before the Supreme Court, the familiar Reckendorfer *vs.* Faber, 92 U. S., page 375, this cloud originally as big as a man's hand suddenly loomed up so black and threatening as to obscure the anticipating capacity of known art, and subordinate it to the idea that the patentee had no standing in court, and no art need be cited. Known art was discussed only to emphasize this dreadful new thing thrust by patentees on an innocent public.

The following quotations show the state of mind of the court:

> "The combination consists only of the application of a piece of rubber to one end of the same piece of wood, which makes a lead pencil. It is as if a patent should be granted for an anticle or a manufacture, as the patentee prefers to term it,

consisting of a stick twelve inches long, on one end of which is an ordinary hammer, and on the other end is a screw-driver or a tack-drawer, or, what you will see in every retail shop, a lead pencil on one end of which is a steel pen. It is the case of a garden rake, on the handle of which should be placed a hoe, or on the other side of the same end of which should be placed a hoe. In all these cases there might be the advantage of carrying about one instrument instead of two, or of avoiding the liability to loss or misplacing of separate tools. The instruments placed upon the same rod might be more convenient for use than when used separately. Each, however, continues to perform its own duty, and nothing else. No effect is produced; no result follows from the joint use of the two." . . .

And again:

"A handle in common, a joint handle, does not create a new or combined operation. The handle for the pencil does not create or aid the handle for the eraser. The handle for the eraser does not create or aid the handle for the pencil. Each has and each requires a handle the same as it had and required without reference to the other end of the instrument, and the operation of the handle of and for each is precisely the same whether the new article is or is not at the other end of it. In this and the cases supposed you have but a rake, a hoe, a hammer, a pencil or an eraser, when you have done." . . .

Still further:

. . . "In the case we are considering the parts claimed to make a combination are distinct and disconnected. There is not only no new result, but there is no joint operation. When the lead is used it performs the same operation and in the same manner as it would do if there were no rubber at the other end of the pencil. When the rubber is used it is in the same manner and

> performs the same duty as if the lead were not in the same pencil. A pencil is laid down and a rubber is taken up, the one to write, the other to erase. . . . There is no relation between the instrument in the performance of their several functions and no reciprocal action, no parts used in common."

In considering the condition defined by the honorable court, let us suppose no one of the combined implements existed today, and that an application were filed for one of them.

The art would show a pencil, a rubber eraser, a pencil, a steel pen, a hoe, a rake, a hammer, a claw, each mounted on its handle.

Separated into pairs according to the loose alternate use to which these tools are put in practice, they would be, the pencil and rubber eraser, the pencil and steel pen, the hoe and rake, and the hammer and claw. Each pair would have two handles.

The applicant in question had formed from this assortment a compound tool, an implement with a single handle having a single tool on each of its ends.

Considering this new implement in its relation to known art and asking with Napoleon, "What has he done?" we see that he has reversed one of two handles carrying tools used alternately, and has merged the two handles in one. By these simple acts he has made three improvements: 1st, a nearly 50 per cent saving of material; 2d, a nearly 50 per cent saving of labor in manufacture, and 3d, a saving everlastingly in the time required to use the tools alternately. That this last item is so far from negligible as to be perhaps the most important one, may be seen from the great emphasis which the new efficiency systems place on the absence of "lost motion."

Could there be a truer triple test of invention?

Suppose as I have said that the producer of this article should file an application, the claim reading:

> "An implement composed of a handle and a tool on each end of the handle."

Diagrammatically this article could be represented by T-H-T.

The problem here obviously did not concern itself at all with any *change* in the intimacy of cooperation of the tools concerned. The intimacy of cooperation remains the same as before. The problem was not one of tools, but of handles. The resulting compound tool falls clearly within the field of "articles of manufacture,"—the court conceded that condition to the pencil—and as clearly satisfies the conditions of invention above stated.

In event of a rejection by the Office on the ground stated by the court, the applicant could very properly explain that the problem was one of handles, that—and this seems to me a very important item—it was necessary for him to recite certain old parts in the claim in order to define his invention, this act being analogous to describing certain old parts in order to make clear the new thing. That he could not define his invention by claiming a handle alone. And that if neither the problem nor its solution was concerned with a *change* of intimacy of cooperation it was difficult to see how that intimacy was concerned with the question of patentability. That he had produced by an act of invention, a thing of legal novelty, falling within one of the statutory classes, and defined in the only clear way.

I believe there is no doubt that the Office would have issued a patent with the above claim.

I believe, further, that if a subsequent applicant had appeared disclosing an implement with a tool on each end, the tools being specifically different from those of the patentee, and had claimed the implement reciting the tools specifically, the Office would have rejected his claim on the patent. Obviously the problem was the same, the solution was the same, and as to the problem and its solution the character of the tool was immaterial, and so in the combination the patented tools would be the full equivalent of the subsequent tools recited.

Also I believe that the patentee could have sued successfully any one who should have made any one of the other combinations. The application of equivalents seems clear.

The honorable court in the pencil case had, literally, at

hand, an apparently complete anticipation of the pencil and rubber claimed, namely, the single handle with a lead on one end and a steel pen on the other. But apparently "aggregation" had grown in so short a time to such proportion as to enclose the vision on all sides. If in the Hailes *vs.* Van Wormer case, through reference to "aggregation," the camel's head entered the tent, in the pencil case the whole animal came in, overturned the tent and scattered the art broadcast.

In pleasant contrast to such a method of treating articles of manufacture presented to the Office for protection, is the treatment of a class of cases disclosing paper or similar articles with printed matter alone or with such matter and one or more simple mechanical features. Examples are a transfer ticket, Cincinnati Transfer Co. *vs.* Pope, 210 F. R., page 443; a menu card, Benjamin Menu Card *vs.* Rand, McNally & Co., 210 F. R., page 285; a bank account book, Time Saver Co. *vs.* Stamford Trust Co., 176 F., page 385. These are but samples of a large number of similar articles. The courts did, indeed, declare many patents on such articles void as not covering things falling within a statutory class. But the ordinary cause of refusal was on prior art alone. Yet in such articles there is very slight, if any, mechanical cooperation between the recited parts. Certain manipulations performed on the complete article, as severing a coupon, punching a hole, folding a sheet, etc., convey certain definite information to the users of them. They cooperate only to affect the mind. Yet neither the Office nor the courts are in these cases anxious to "see the wheels go round." The articles are considered as things embodied in visible, tangible form, and facilitating the conduct of human affairs. In determining their patentability the courts treat them as units, and anlyzing, but not dissecting them, compare them with the total embodiment in units solving similar problems, and decide whether their existence occurred through the inventive act claimed.

Robinson says in Vol. 1, page 273, footnote:

> "It may well be doubted whether many of the cases which have been decided against the patentees of manufactures on the ground that the

> instrument claimed was a mere aggregation have not been governed by principles applicable rather to machines than manufactures, and really meritorious inventions been thus denied the protection of the law."

And above, on the same page:

> "In a manufacture the law of operation is in the source from which the motive power is drawn; and the action of the instruments in their united state, so far as depends upon the instruments themselves, often remains the same as before they were united."

May not the reason for the adverse decisions referred to lie in the failure to recognize the condition intimated above herein, that it may be necessary, in order to define the actual invention, to recite in connection with it certain old things, although neither the problem nor its solution is concerned with a *change* in the cooperative interrelation of those things? Under such a condition apparently the intimacy of interrelation has no bearing on the question of invention.

I find no other court case in which the invention has been treated like the unfortunate pencil, and rejection on art refused in the direct presence of apparently sufficient anticipating art. Is it possible that this notorious pencil stands on its rubber heel, its lead pointed skyward, and satsifies that hackneyed legal phrase "a lonesome monument of error?"

The later court cases seem in line with Hailes *vs.* Van Wormer to have uniformly defined "aggregation" as an unpatentable combination of *old* things. Robinson, in his discussion of aggregation seems to leave it uncertain whether the term should be extended to combinations in which a part or all of the elements are specifically new, although he states clearly that in a true combination it is immaterial whether the elements are old or new.

But the "aggregation" now most commonly used in the Office is applied to combinations, some or all of the parts of which are specifically new, some art being usually cited; although in case of Ex parte Potter, Mss. Deci-

sions of the Commissioner, 1905, the citation of references was refused. The reason for this refusal was stated to be that "aggregation is a question of invention and not of novelty." Reference was made to common knowledge of the broad combination, apparently implying that applicant had disclaimed this broad combination since he claimed a specific combination having added features.

Thus aggregation has possessed three definitions. An unpatentable combination of old elements (Hailes *vs.* Van Wormer); second, a combination falling properly within one of the statutory classes, but including elements cooperating so loosely as to fall outside the pale of claimed things which demand anticipation by known art (Reckendorfer *vs.* Faber); third, a combination, some or all of the elements of which are new, and presenting a condition in which some art is usually cited, but need not be.

Recently the existing confusion of definitions of the term was considered by the court. Krell Auto Grand Piano Co. of America *vs.* Story et al., 207 F., page 946, said:

> "In the books the word 'aggregation' is used in different senses."

And, after discussion of such "aggregation" as the court defined in Hailes *vs.* Van Wormer, and as the Office defined in Ex parte Potter, continued:

> "In another sense (which, in the interest of accurate terminology, might well be taken as the exclusive sense), 'aggregation' means that the claims, in and of themselves, independently of the prior art, show that the elements are incapable of coacting to produce a unitary result. Illustrative of this is the case of Reckendorfer *vs.* Faber."

This definition seems to be a limitation to the Reckendorfer *vs.* Faber condition. If so, it is hoped that the above discussion has shown the danger of using such a definition.

It seems to me fundamental that in arriving at an issue between parties no word of uncertain meaning should be

employed. If, then, Rule 66 is to be followed, and the best art is to be cited, the use of the word "aggregation" becomes a mere postscript, and is superfluous. If no art or less than the best art is considered sufficient in view of "aggregation," surely the applicant should be informed of the particular kind of "aggregation" of which he is guilty.

At a gathering of the Patent Bar Association and the examiners some time ago, one of the speakers, referring to the loose use of the term by the Office, quoted a member of his firm as saying "I have been in the patent business for a long time, but I don't yet know what an aggregation is."

Because of the easily possible loose use of the term, by reason of its variety of definitions, the word is, as I have said above, never used in our division. A new assistant, especially, might look on it as a convenient word, pointing to a path of least resistance. So the sign: "No thoroughfare" is placed at that path. Some Office letters which I have seen connect "aggregation" with such loose expressions as "illegitimate combination," "not a sufficient intimacy of relation between the elements," "no cooperation between the specific parts of the combination;" although in the last case, of course if two parts cooperate in their simple embodiments they cooperate none the less in their most elaborate embodiments. Indeed these various definitions leave the word so fluid that a new assistant may be tempted to pour it onto references perhaps thought to be weak in themselves, so that the cup of rejection may overflow, or it may be used as a sort of basting fluid so that the rejection shall be done to a turn. Therefore in our division it is "anathema," and the "aggregationist" is unknown.

Certainly if "aggregation" is to be used, it is only just to applicants that authoritative definitions of it be devised, so that in a given rejection for "aggregation" the applicant may understand precisely the form of "aggregation" used in that rejection. If when the Office "goes into action," it is thought desirable to "fire" "aggregation" at the applicant, it should surely be in the form of a single bullet, properly identified as a "steel point," "dum-dum," or what not, instead of a discharge from a shot gun, leaving the unfortunate man to wonder,

as he perhaps picks some shot from his person, whether the gun was fired merely on account of its report, and what part of the charge was really intended or expected to hit him.

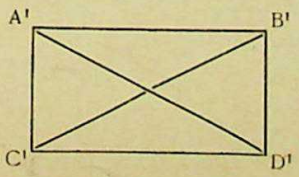
I have referred, in connection with Ex parte Potter, above, to an intimation therein of "disclaimer."

It seems to me quite unjust to reject a claim on the ground that what is not claimed is "disclaimed," and that the claimed matter is not patentable over the "disclaimed" matter.

"Disclaimer" is used in the statute as a means for restricting patent claims, and often in the courts also as a means to prevent a patentee from extending the scope of his actual claim in the endeavor to prove infringement of it. In connection with the latter procedure the court often states that a patentee disclaims any broader matter than he claims. Possibly Office rejection on "disclaimer" is due to the importation of that court statement into the Office, and the deduction that it applies to claims in a pending application.

But the ordinary procedure in the Office is, as in the Potter case, a sort of "selective disclaimer," and a judgment as to patentability is based on that selected form. The principle, however, if correct, must extend to all the matter disclaimed, since the apparent basis is that "all matter not claimed is disclaimed."

In the Potter case there were four elements, the base, the reflector, the lamp and the top, specifically claimed. A combination to them could be represented by A′-B′-C′-D′. On the "disclaimer" principles not only was the combination A-B-C-D disclaimed, but A′-B′, A′-C′, A′-D′, B′-C′, C′-D′, A′-B′-C′, A′-B′-D′, A′-C′-D′, and B′-C′-D′. Diagrammatically, this condition could be represented by a rectangle with diagonal lines joining the corners, and with one of the letters standing at each corner:



Thus, in such a combination everything is "disclaimed" excepting a combination in which each element modifies all the others, that is, it comes within the well-known Pickering *vs.* McCullough principle, long since decided to be unjust, and obviously especially so as to processes involving a succession of steps, and as to mechanism for carrying out such processes.

If "disclaimer" were applied to a claim for a valve-head having an annular hard-metal face with an edge, in combination with a valve-seat having an annular soft-metal face with a groove to receive said edge, the applicant would be assumed to have "disclaimed" the specific head per se and the specific seat per se, because he did not claim either separately. But inasmuch as the specific head and seat are capable of use only with each other, there could be no possible patentability in combining them; hence no combination claim could be allowed.

But, it is sometimes said, the "disclaimer" principle really results in broadening the claim first presented, because applicant after rejection on "disclaimer" may substitute a claim to the broader matter first disclaimed, and so be "properly" protected.

Assume a cutlery manufacturer who presents to the Office a disclosure of a rolled-metal butter-knife having its handle and blade integral, the handle and blade in planes at right angles to each other and connected by a twisted portion. (It may be stated that this is a well-known article, practically confined to butter knives.)

Assume also that the art shows no metal article of any kind so formed. Under "disclaimer," a claim to a "butter-knife" of that character would be rejected, as a "knife" broadly is disclaimed, and no patentability lies in using for butter a knife so made. But a claim to a "knife" disclaims a "tool," such for instance as a hammer so made. A claim for a "tool" disclaims "an article" so made, for instance a brace in a metallic structure. In view of all this the said cutlery manufacturer claims "an article" having the characteristics which have been noted; and so issues "fully protected." It subsequently develops that "an article" of the kind has been used to support a sign in a certain position. The claim is void.

If the original claim to a butter-knife had been compared with art, and the sign post had been discovered in

the search, would the Office or the court have rejected that piece of cutlery on the post? I don't believe so.

Further, such "disclaimer" procedure seems to deny the privilege allowed by the familiar Ex parte Eagle, of having a specific claim in addition to a generic claim.

"Disclaimer" would have rejected McNeil on his "disclaimer" of S, of S', of T, and of S-T.

Still another reason sometimes given for refusal to cite art in determining novelty and invention in a claim is that the claim should first clearly "define" the exact invention. Ordinarily this reason is given where one or more of the features recited do not, in the Examiner's opinion, actually take part in the combination on which the claim is based.

This treatment of a claim seems to me to be more reasonable than refusal of citation of art on the ground of "aggregation" or "disclaimer," because, here at least, an actual concrete thing is under observation; and whether all of the recited "lines,"—that is, the lines assumed to designate the known capabilities and properties of the elements—have actually become bonds between co-operating elements in the combination, or are inactive, idle lines, may be accurately determined.

But I can see no authority in the law or the courts for this procedure. It is true that the courts, in considering an invention so pioneer that no anticipating art is known even for the broadest embodiment of its idea, often quote Sec. 4888 to the effect that the applicant "shall particularly point out and distinctly claim," etc. And just as, perhaps, "disclaimer" was imported from the courts to the Office, the "particularly point-out" plan may have so entered.

In summary, as to rejection of application claims, I believe there is no legal authority for the refusal to cite existing pertinent art when the question for determination is "novelty" or "invention."

Mr. Robinson has treated Office procedure as to claims in his usually exhaustive way. He makes it clear that a person precedes his entrance to the Office as an applicant, by making what he supposes to be a patentable invention. He is possessor of a certain "sum of information" as to a certain art. He conceives of something which to him is an improvement in the art, and his conception is suffi-

ciently clear to be disclosed to the Office. Even in view of his limited "sum of information" his new thing may be the result only of the exercise of mechanical skill. It may however, be the result of a true inventive act.

But even such an inventive act is not necessarily entitled to reward in the form of a patent. For says Robinson, Vol. I, page 159:

> "The knowledge of mankind in general concerning any of the factors of the idea of means does not, however, demonstrate that the inventor shared such knowledge. Whatever information others may have possessed, the attributes of those factors may be new to him and have been ascertained by a true process of discovery. . . . But as its only object"—that is, the object of the patent law—"is to confer exclusive privileges on the first inventor, it consistently refuses to regard any exhibition of inventive skill, the result of which could have been attained by applying the constructive process to the discoveries of others."

Thus a person, though a *true* inventor in view of his own previous "sum of information" is not a *"legal"* inventor; that is, an inventor in view of the "sum of information" possessed by those fully skilled in the art concerned. An ordinary applicant for a patent is thus honestly of the belief that he has performed an act of invention, that judgment being based on his "sum of information;" and if he desires a patent he follows the instructions of Sec. 4888.

It is well to note that although Sec. 4888 by implication states the proper form of a patent, it is in reality addressed not to patentees, but to applicants. So that its direction that the claim must "particularly point out," etc., is not a direction to present a claim which the Office will declare to be patentable, but is to define what applicant *believes* to be his invention. Thus he comes to the Office with "clean hands" if he definitely states what he believes to be his invention. But, reiterates Robinson on page 305 of Vol. I:

> "An inventor does not become entitled to a patent merely by exercising his creative faculties

> in the production of an art or instrument. The consideration for the grant of his exclusive privilege is the benefit which he confers upon the public by placing in their hands a means through the use of which their wants may be supplied. If the same means has been already made accessible to them by the inventive genius of a prior inventor, . . . no benefit results to them from his inventive act, and there is no consideration for his patent."

Robinson obviously here implies that "intrinsic" invention is not necessarily "legal" invention. He continues:

> "In order, therefore, that an invention may be patented or protected by a patent it must be new, that is, bestowed for the first time upon the public by the patentee."

And later, on the same page he defines "legal novelty:"

> "'Novelty,' therefore, exists unless the invention is already in the possession of the public as an operative art or instrument, and this occurs only when the invention itself is a matter of existing public knowledge, *or is derivable from what is known without the further exercise of inventive skill. In other words as every variation of form, as distinguished from variation in substance, is considered as effected by the imitative faculties, novelty consists in the substantial variation of the invention in question from all inventions which in the contemplation of the law, are already open to the public.*"

From this exhasutive definition of "legal invention" Robinson discusses "novelty" through over 150 pages. He, indeed, states, Vol. 2, page 140, that the applicant shall include in his claim only such parts as are necessary to define the real invention; but this again is based on the applicant's "sum of knowledge," and if a patent results the claim almost never issues in the form originally presented. One duty of the Office is to see that the claim

shall issue in proper form. In Vol. 1, page 155, Robinson says:

> It is the duty of the Patent Office to secure the correct statement of the claims before it allows the issue of a patent. That the courts might sustain a defective claim, in order to prevent the defeat of a granted patent, is no reason for permitting such a claim to pass the scrutiny of the department. The claim is to define what the Patent Office, *after due examination*, has ascertained to be the real discovery of the inventor, and it must be amended or withdrawn according to the judgment of the officers to whom this duty is committed. Once settled in its terms by their decision, the courts will not disturb it, either by interfering with its language or by narrowing or enlarging it by construction.

Thus we have the applicant coming to the Office with a "clean bill" and the Office prepared to investigate his right to a patent.

The statute then turns its attention to the Office, and in Section 4893 directs the Commissioner to "cause an examination to be made of the alleged new invention or discovery; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor."

And further, the statute in Section 4903 instructs both the Office and the applicant as to examination procedure:

> "Whenever on examination any claim for a patent is rejected, the Commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice, the applicant persists in his claim for a patent, with or without altering his specification, the Commissioner shall order a reexamination of the case."

In considering this question of "legal novelty" which, as we have seen from the quotations above, includes "legal inventions," I find no statement or intimation in Robinson's work that the Office may test this question except by the consideration of the claimed invention as a "unit"—he uses the word "unit" repeatedly—and the direct comparison of it with the total disclosed embodiment which furnishes the "sum of information" possessed by those fully skilled in the art concerned, when any such art exists. (At rare intervals there are presented to the Office inventions so pioneer in character that there is no known anticipating art.)

Everywhere the procedure is a comparison between concrete things. The applicant was confronted with what was to him a problem. He solved that problem. No matter whether that solution resulted from only mechanical skill or from invention. No matter whether the solution is new or old. It is a solution.

As an applicant he complies with Section 4888. Robinson implies in the quotation above, from his page 305, that a patent shall be granted on the presented claim if its subject-matter has "legal novelty" and utility.

As to claims which recite features not material to the actual combination on which the claim is drawn (McNeil), he says in a footnote in Vol. I, page 389, referring to both the claim and the art compared with it to determine "novelty:"

> "But it is essential, when all immaterial parts are excluded, and the true constituent elements of each combination alone remain, these elements in each combination should be equivalents of all those in the other."

This procedure has the very great advantage that there is direct comparison between concrete things, instead of comparison between a concrete thing presented to the Office, and the definition of a term or expression like "aggregation," "disclaimer," "particularly point out," etc.

That the avoidance of these terms and expressions in Office practice is not fatal appears from the nearly nine

years existence of Division 39. During that time thousands of cases have been acted on; hundreds have been [illegible]d, before or after final rejection; and I am glad to say, many have been allowed. I believe that more applications have been finally disposed of than would be the case under any other procedure.

I should like to touch briefly on another phase of the citation of art.

It is recognized that the relation between a patentee and the public is in the nature of a contract.

A thing having been found to be patentable, as to that invention the applicant is related to the public as a creditor to a debtor. He may abandon all of his invention to the public. Why should the present law be interpreted to require that he shall abandon all, or none; that he shall give everything or demand his "pound of flesh;" and so compel him to define his actual invention in the broadest form?

A patentee is at liberty to treat the public as a licensee or grantee, and so abandon a part of his patent right. Why may not the statement of his duty to claim his invention be construed merely to mean that he must define clearly the bounds of the monopoly he desires, even though it be less than he is entitled to? An ordinary creditor may give a receipt in full when less than the whole amount of the debt is paid, if he is willing to do so.

Abandonment of a part of a monopoly to which an applicant is entitled would appear in a claim in the form of the recitation of unnecessary limitations. Suppose McNeil had known he was entitled to a monopoly on his new stitcher for all of its uses, but as a practical manufacturer cared only to use it in connection with a trimmer, dedicating all its other uses to the public. The court would hold him strictly to his limited monopoly. Who would be injured? Would not the Office duty be complete if it should inform the applicant of the true breadth of his monopoly, and leave him to deliberately restrict it as he desires?

A practice of allowing such limited monopolies would immensely simplify Office practice, a combination claim then being allowed if it contains a novel element.

Under this theory the McNeil claim would have been allowed, as well as the butter-knife claim above.

The McNeil claim could, therefore, according to the various theories of Office practice, be refused action as an "aggregation" (ex parte Potter); could be rejected on "disclaimed matter" disclosed; rejected as failing to "define" the invention; rejected on an equivalent, as was actually done; or, under the last-mentioned theory, could be allowed.

If rejections are to be based wholly or partly on "aggregation," "disclaimer" and "particular definition" in the claim, there should at least be authoritative definitions of those terms. Judgment as to patentability in view of a particular disclosure of art must, apparently, always be influenced by the personal factor. But as to the other fundamentals of Office practice there should be such accurate and widespread information that the personal factor would not influence the action. All applications are addressed to the Honorable Commissioner of Patents, and so far as is possible, all applications should be examined as if they were examined by him.

Rules 66 and 68 interpreting Section 4903 above quoted are the two "golden rules" of our official daily conduct. Figuratively their language should be on the wall of every division. As to these rules we should be strict constructionists, and insist on following the first rule and that applicants shall follow the second rule. In this way cases can be really and rapidly progressed.

In spite of the academic familiarity with these two rules the first paragraph of each is worthy of frequent repetition.

> "Rule 66. Upon the rejection of an application for want of novelty the Examiner must cite the best references at his command. When the reference shows or describes inventions other than that claimed by the applicant, the particular part relied on will be designated as nearly as practicable. The pertinence of the reference, if not obvious, must be clearly explained and the anticipated claim specified."
>
> Rule 68. "The applicant has a right to amend before or after the first rejection or action; and he may amend as often as the Examiner presents new

> references or reasons for rejection. In so amending the applicant must clearly point out all the patentable novelty which he thinks the case presents in view of the references cited or the objections made. He must also show how the amendments avoid such references or objections."

It should be remembered that the time of a great many patent solicitors is more valuable commercially than the time of the examiners. Their clients pay more for their services than the Office pays the examiners, and many solicitors are paid according to the actual time employed on a case. It is due to applicants, therefore, that every Office action should be so definite that time need not be wasted in determining its meaning; and every action of an applicant should be equally clear.

I believe the greatest material thing in any country is its natural resources; the next, the defense of those resources; and then the development of those resources by the peaceful development of the arts and sciences. This development is practically synonymous with civilization.

But men are not yet so altruistic as to spend time, money and thought in such development without the prospect of financial return. Therefore every progressive country has its patent system. Our patent system thus stands on this lofty plane in relation to the welfare of our country; and everybody connected with it, in or out of the Patent Office, should be proud of that connection, and anxious to assist in doing the greatest good to the public by the exercise of the maximum efficiency. And in that efficiency, uniformity and consistency in practice are a large factor.

April 8, 1915.